

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Customer Number: 46320
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Frank LEYMANN, et al.	:	Confirmation Number: 5078
	:	
Application No.: 10/042,799	:	Group Art Unit: 2157
	:	
Filed: January 9, 2002	:	Examiner: A. Gold
	:	
Appeal No. 2008-1050	:	
	:	
For: MANAGING A FAILURE TO ACCESS A DATABASE IN A COMPUTER SYSTEM	:	

REQUEST FOR REHEARING

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Request for Rehearing is submitted under 37 C.F.R. § 41.52 in response to the Decision on Appeal dated September 24, 2008 (hereinafter the Decision). This Request for Rehearing is timely filed within the two month time period for reply set forth under 37 C.F.R. § 41.52(a)(1).

Appellants respectfully submit that in the Decision on Appeal, the Honorable Board either misapprehended and/or overlooked certain arguments presented by Appellants in the Appeal Brief of November 22, 2006, and in the Reply Brief of August 14, 2007. Appellants will specifically identify these particular points below.

REMARKS

Decisions of the PTO tribunals are reviewed in accordance with the standards of the Administrative Procedure Act. See Dickinson v. Zurko, 527 U.S. 150, 165 (1999) (applying the Administrative Procedure Act, 5 U.S.C. § 706, to appeals of PTO rulings). Thus the Board's factual findings are reviewed to determine whether they are unsupported by substantial evidence, and the Board's legal conclusions are reviewed for correctness in law. See In re Gartside, 203 F.3d 1305, 1312 (Fed. Cir. 2000).

In the last two full paragraphs on page 6 of the Decision, the Honorable Board made the following assertions:

Accordingly, the issue is whether Helmer discloses "sending a request of the application client for the first application server from the first application server to the second application server while the first one of the two application servers fails to access the database" (Claim 1).

We agree with the Examiner's finding that Helmer discloses such claimed limitation beginning at page 5 of the Answer, and the Examiner's corresponding responsive arguments beginning at page 7 of the Answer.

At the outset, Appellants note that the Honorable Board mischaracterized the Examiner's analysis and findings. At no point during prosecution has the Examiner asserted that Helmer discloses "sending a request of the application client for the

first application server from the first application server to the second application server while the first one of the two application servers fails to access the database."

Referring to paragraph spanning pages 4 and 5 of the Examiner's Answer, the Examiner is relying upon the combination of Holmberg and Rizvi to teach the limitation of "a failure to access a database." The first two full paragraphs on page 5 of the Examiner's Answer are reproduced below:

Holmberg and Rizvi fail to teach the limitation further including sending a request of the application client (15) for the first application server (21) from the first application server (21) to the second application server (20).

However, Helmer teaches a geographic data replication system and method for a network (see abstract). Helmer teaches the use of a failed server routing requests to a remote server for processing (col. 2, lines 2-15, 46-59).

Completely absent from the Examiner's analysis with regard to Helmer is any mention of Helmer being used to teach the claimed "while the first one of the two application servers fails to access the database."

Referring to second full paragraph on page 8 of the Examiner's Answer, the Examiner asserted the following:

The Appellant argues Helmer does not teach a failed server routing requests to a remote server and reproduces the column and line numbers, column

2, lines 2-15 and column 2, lines 46-59, from the Examiner's rejection in their appeal brief. The limitation in question is explicitly shown in both sections in column 2 on lines 11-13, "If a server fails, such as the local server, the remote server begins processing user requests based on the temporary data it received from the local server." and lines 53-54, "If the local server fails, the user request is routed to the remote server." As disclosed in these passages, Helmer clearly teaches "a failed server routing requests to a remote server."

Also absent from this passage is any discussion by the Examiner, while characterizing the teachings of Helmer, of the claimed "while the first one of the two application servers fails to access the database."

Therefore, for the reasons presented above, Appellants respectfully submit that the Honorably Board has mischaracterized the Examiner's analysis and findings by asserting that the Examiner has made a finding of fact that Helmer discloses "sending a request of the application client for the first application server from the first application server to the second application server while the first one of the two application servers fails to access the database." For reasons that will be discussed in greater detail below, this mischaracterization of the teachings of Helmer has caused the Honorable Board to misapprehended and/or overlook two sets of arguments presented by Appellants in the Appeal and Reply Briefs.

1 Although the Examiner has not asserted that Helmer discloses "sending a
2 request of the application client for the first application server from the first
3 application server to the second application server while the first one of the two
4 application servers fails to access the database," Appellants recognize that
5 Honorable Board's characterization of the teachings of Helmer could be
6 intentional.

7
8 If so, designation as a new ground is necessary because Appellants have not
9 had a fair opportunity to react to the thrust of the "affirmance" of the rejection,
10 which is based upon a characterization of the prior art that was not relied on by the
11 Examiner. See In re Kumar, 418 F.3d 1361, 1367-68 (Fed. Cir. 2005) ("the
12 ultimate criterion of whether a rejection is considered 'new' in a decision by the
13 board is whether appellants have had fair opportunity to react to the thrust of the
14 rejection") (quoting In re Kronig, 539 F.2d 1300, 1302 (CCPA 1976)). In the
15 present situation, Appellants have not have had a fair opportunity to react to the
16 assertion that Helmer discloses the entire limitation of "sending a request of the
17 application client for the first application server from the first application server to
18 the second application server while the first one of the two application servers fails
19 to access the database." Appellants have already addressed the first part of the
20 limitations, but have not had the opportunity to address the assertion that Helmer

1 teaches "while the first one of the two application servers fails to access the
2 database."

3
4 As to the limitations of "while the first one of the two application servers
5 fails to access the database," a textual search of Helmer fails to yield even a single
6 instance of the word "database." Helmer, however, does refer to file servers 16A,
7 16B, which could be considered a database. Regardless, Helmer does not teach
8 that an application server (presumably corresponding to utility servers 18A, 18B)
9 failing to access a file server 16A, 16B). Instead, referring to column 7, lines 20-
10 43, Helmer teaches that the data center 14A/14B becomes "unavailable" or "fails."
11 As such, Helmer does not teach the limitation of "while the first one of the two
12 application servers fails to access the database."

13
14
15 In the first two full paragraphs on page 7 of the Decision, the Honorable
16 Board asserted the following:

17 Helmer discloses that, when a local server fails, the user requests
18 **processed by the failed data center are routed to the remote server (using any**
19 **routing technique)**, and the remote server begins processing user requests based
20 on the temporary data it **received from the local server** (FF 1). The Examiner
21 finds that "Helmer clearly teaches 'a failed server routing requests to a remote
22 server'" (Ans. 8). We generally agree.

1 We find that Helmer clearly teaches that the remote server receives data
2 (such as temporary data) from the local server, and that the user requests that are
3 processed by the failed local server are routed to the remote server (FF 1). Thus,
4 we find that Helmer teaches, or at the least, strongly suggests, that the request is
5 sent from the failed local server (that processed the request) to the remote server.
6 In fact, an artisan would have understood that it would have been obvious to
7 select the local server as the server from which to send the request that it
8 processed, to the remote server, because the remote server regularly receives data
9 from the local server, and the artisan is a person of ordinary creativity, not an
10 automaton. *See KSR*, 127 S. Ct. at 1742. We find that such sending of the request
11 from the local server is merely simply incorporating the local server to perform
12 the same function it had been known to perform, yielding merely expected results,
13 and thus, such incorporation is obvious. *See KSR*, 127 S. Ct. at 1740. (bold in
14 original, underlined added)

15
16 Based upon the Honorable Board's statement that "Helmer teaches, or at the
17 least, strongly suggests, that the request is sent from the failed local server," the
18 Honorable Board does not appear to be entirely convinced that Helmer explicitly
19 teaches the request is sent from the failed local server to the remote server.

20
21 The Examiner and the Honorable Board has relied upon the teaching of
22 "using any routing technique" from column 7, line 37 of Helmer. However, as
23 argued in the paragraph spanning pages 5 and 6 of the Reply Brief, Helmer is silent
24 as to the entity performing the routing of the user request to the remote server. As

1 claimed, the server (while failing to access the data) is required to route the
2 request.

3
4 Moreover, as also argued in the Reply Brief, within the same sentence of
5 Helmer that the statement "using any routing technique" is found, Helmer teaches
6 using the routing technique described in U.S. Patent Application No. 09/021,091
7 (issued as U.S. Patent No. 6,735,631). As described therein, a redirector 16
8 changes the destination address of a user request to redirect the user request to one
9 of a plurality of application server 12a, 12b. The redirector 16 is also described as
10 also using this technique for failover. Therefore, based upon the **only explicit**
11 teaching provided, Helmer does not teach that the first application server routes
12 requests to the second application server, as claimed. Instead, Helmer teaches the
13 use of a redirector 16, which is separate from an application server, that provides
14 the routing.

15
16 Referring to the underlined passage of the above-reproduced assertions from
17 the Decision, the Honorable Board asserted that "sending of the request from the
18 local server is merely simply incorporating the local server to perform the same
19 function it had been known to perform, yielding merely expected results, and thus,
20 such incorporation is obvious." These assertions were not previously presented by

1 the Examiner. As such, Appellants have not had a fair opportunity to react to the
2 thrust of the "affirmance" of the rejection.

3
4 Although Appellants are reluctant to give any particular argument more
5 importance than other arguments, the next set of arguments are extremely
6 important in clarifying (i) why Helmer does not teach using the failed server to
7 forward to request or why such a teaching would have been obvious. Specifically,
8 the assumption that the local server "perform[s] the same function it had been
9 known to perform, yield merely expected results" is factually incorrect.

10
11 Helmer clearly and unambiguously states that the local server has "failed"
12 (see column 7, line 35, "[i]f one data center 14A or 14B fails") and/or is
13 "unavailable" (see column 7, lines 23-25, "[i]f data center 14A becomes
14 unavailable" and column 7, lines 28-29 "[w]hen data center 14A is not available").
15 Thus, based upon the teachings of Helmer that the local data center has "failed"
16 and/or is "unavailable," the local data center does not perform the same functions it
17 had been known to perform. Since the local data center cannot perform the same
18 functions it had been known to perform (i.e., the processing of the request), one
19 having ordinary skill in the art would recognize that the local data center is very

1 likely also incapable of not performing other functions that the local data center
2 had previously been capable of performing.

3
4 The reasoning behind this is firmly grounded in common sense. For
5 example, if the local data center has failed/is unavailable because a power supply
6 serving the local data center has gone bad, the local data center would be incapable
7 of performing any function. Similarly, the local data center may have
8 failed/become unavailable because the switch 22A/22B is inoperative, in which
9 instance, the local data center cannot communicate with any entity (including the
10 remote server), and thus, the local data center cannot forward the request to the
11 remote server. Based upon these and a multitude of other possible examples why
12 the local data center may have failed/become unavailable, one skilled in the art
13 would recognize that the other functions that the local data center was previously
14 capable of performing are also likely not available when the local data center is
15 being characterized as failed/unavailable.

16
17 The Honorable Board asserts that Helmer strongly suggests that the request
18 is sent from the failed local server to the remote server. Appellants respectfully,
19 yet vigorously disagree. In fact, Helmer strongly teachings the use of a redirector
20 to route the requests during failover, which does not support the Honorable Board's

1 assertion. Moreover, this use of a redirector for routing is a common sense
2 approach that would be readily adopted by one skilled in the art for obvious
3 benefits. Specifically, since the local data center has failed/is unavailable, relying
4 upon the local data center to route the request to the remote data center would incur
5 the substantial risk that the request would never be forwarded to the remote data
6 center. However, by employing a redirector, as explicitly taught by Helmer, the
7 request would be forwarded using a component (i.e., the redirector) that has not
8 been deemed failed/unavailable, as with the data center. As such, Appellants
9 respectfully submit that the obvious combination based upon the teachings of
10 Helmer would employ a redirector to route the request to the remote data center so
11 as to ensure that the remote data center actually received the request.

12
13

14 On page 8, lines 4-7 of the Decision, the Honorable Board asserted the
15 following:

16 We find that such routing of the user request when the local server fails of Helmer
17 occurs in various situations ***including*** while the local server fails to access the
18 database. (emphasis in original).

19
20 As noted above, the Honorable Board's factual findings are reviewed to determine
21 whether they are unsupported by substantial evidence. In this instance, the
22 Honorable Board's finding that the routing of a user request, when the local server

1 fails, occurs while the local server fails to access the database is entirely
2 unsupported by substantial evidence. Neither the Examiner nor the Honorable
3 Board has ever pointed to a specific explicit teaching within Helmer to support
4 such a finding. Thus, the Honorable Board's finding is not supported by substantial
5 evidence.

6
7

8 On page 8, lines 7-9 of the Decision, the Honorable Board asserted the
9 following:

10 In fact, an artisan would have understood that the routing occurs while the local
11 server fails since the purpose of the Helmer invention is for the remote server to
12 process the data when the local server fails.

13
14 Appellants do not disagree with this characterization of the teachings of Helmer.
15 However, these teachings do not lead to the claimed invention. These teachings
16 discuss the importance of routing the request to the remote data center. However,
17 the claimed invention is not directed to "routing," in general. Instead, the claimed
18 invention is directed to a specific type of routing. Moreover, Helmer teaches a
19 specific type of routing (i.e., the teachings of U.S. Patent No. 6,735,631, which
20 was cited by Helmer) which can be performed by a redirector (and not the local
21 data center).

1
2
3 On page 8, lines 9-14 of the Decision, the Honorable Board asserted the
4 following:

5 Contrary to Appellants' argument that the Examiner "failed to put forth a realistic,
6 common sense rationale," we find that such routing of the request while the server
7 fails is merely the server performing the same function that it has been known to
8 perform, yielding expected results. Thus, we find that the subject matter as a
9 whole would have been obvious to the artisan.

10
11 Although Appellants have addressed this assertion when it was made on page 7 of
12 the Decision, Appellants will address other aspects of this assertion in greater
13 detail.

14
15 At the outset, Appellants note that, within the Decision, the Honorable
16 Board has essentially ignored the Examiner's asserted motivation for making the
17 proposed combination (i.e., "[a] faster and more efficient way to send a request
18 from the first server to the second server"). Instead, the Honorable Board is
19 relying upon a different analysis. Although not explicitly stated, the Honorable
20 Board appears to be relying upon Rationale B (i.e., "Simple Substitution of One
21 Known Element for Another To Obtain Predictable Results") described within the
22 "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in

1 View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.," 73
2 Fed. Reg. 57,526 (2007) (hereinafter "Examination Guidelines").

3
4 On the contrary, the Examiner appears to relied upon rationale G (i.e.,
5 "Some Teaching, Suggestion, or Motivation in the Prior Art That Would Have Led
6 One of Ordinary Skill To Modify the Prior Art Reference or To Combine Prior Art
7 Reference Teachings To Arrive at the Claimed Invention"). As discussed in the
8 Examination Guidelines, each rationale requires a different set of findings that
9 must be articulated before a particular rationale can be employed. Since the
10 analysis employed by the Honorable Board is completely different that that
11 presented by the Examiner, Appellants have not had a fair opportunity to react to
12 the thrust of the "affirmance" of the rejection.

13
14 As already argued above, the Honorable Board's has erred in asserting that
15 the server would perform the same function that it has been known to perform,
16 yielding expected results. The local data center is characterized as
17 failed/unavailable, and thus, one skilled in the art would have recognized that the
18 local data center is not capable of performing that same functions that the local
19 data center was once capable of performing. Thus, the results of such a
20 combination, as proposed by the Examiner, could not be expected with any

certainty. Therefore, the Honorable Board has not properly articulated the findings necessary to establish obviousness under rationale B within the Examination Guidelines.

A finding that the Honorable Board presumes, without basis, is that "the server [performs] the same function that it has been known to perform" and this function is that the local data center forwards a request to the remote data center. However, Helmer does not teach that the local data center, while available, forwards the request to the remote data center. Instead, as discussed on page 5 of the Reply Brief, Helmer teaches sending temporary data from the local data center to the remote data center. As such, the Honorable Board's finding that "the server [performs] the same function that it has been known to perform" is based upon speculation as to what the local data center "has been known to perform" and not based upon substantial evidence.

On pages 8 and 9, under the heading "It Would Have Been Obvious to Combine the References," the Honorable Board proceeds to conclude that "[w]e find that a person of ordinary skill will be able to fit the teachings of Holmberg, Rizvi, and Helmer together like pieces of a puzzle since the person of ordinary skill

1 is also a person of ordinary creativity, not an automaton." However, the content of
2 the Honorable Board's writings are either citations to case law or conclusory
3 statements. The Honorable Board does not refer to any of the specific arguments
4 made by either Appellants or the Examiner. Moreover, the Honorable Board
5 doesn't explain, in any detail, why the claimed invention would have been obvious
6 to one skilled in the art.

7
8 As noted by the Supreme Court, "rejections on obviousness grounds cannot
9 be sustained by merely conclusory statements; instead there must be some
10 articulated reasoning with some rational underpinning to support the legal
11 conclusion of obviousness." KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1741
12 (2007) (quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)). The Honorable
13 Board's opinion, however, neither supplies this articulated reasoning or refers to
14 the reasoning of the Examiner. Moreover, Appellants respectfully submit that the
15 Honorable Board asks the wrong question. The question is not whether or not it
16 would have been obvious to combine the applied prior art – Appellants' concede
17 that it could have been obvious to combine the cited references. The question to be
18 answered is whether the claimed invention would have been obvious based upon
19 the combined teachings of the applied prior art. The fact the references can be

combined does not necessarily lead to the conclusion that the claimed invention would have been obvious.

By asserting that "a person of ordinary skill will be able to fit the teachings of [the applied prior art] together like pieces of a puzzle" while ignoring the requirement for some articulated reasoning with some rationale underpinning, the Honorable Board has presented a conclusion that is applicable to any combination of references that allegedly teach each limitation of any claimed invention. As noted by the Federal Circuit, "virtually all [inventions] are combinations of old elements." In re Rouffet, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998) (quoting Environmental Designs, Ltd. v. Union Oil, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1993)). As such, to establish obviousness, there is still a need to set forth an analysis despite the applied prior art allegedly teaching all of the claimed limitations. Otherwise, "virtually all" inventions would be obvious.

On pages 6-8 of the Appeal Brief, Appellants presented arguments as to (i) the Examiner's failure to consider the claimed invention as a whole and (ii) the Examiner's failure to provide factual support for the Examiner's proposed motivation. These arguments were also continued on pages 3-7 of the Reply Brief.

1 However, the Honorable Board has not addressed, with any specificity, most of
2 these arguments.

3
4 For example, the Honorable Board has not noted (or commented upon)
5 Appellants' specific arguments that the Examiner's alleged motivation for the
6 combination is factual unsupported and, in fact, leads away from the claimed
7 invention (i.e., sending a request to the remote data center via the local data center
8 is slower and less efficient than sending the message directly to the remote data
9 center). This concept was also addressed in the paragraph spanning pages 1 and 2
10 of the Reply Brief. Specifically, three references (Holmberg, Rizvi, and U.S.
11 Patent No. 6,375,631, which was cited by Helmer) discuss using agencies (i.e., a
12 device) outside the first application server (e.g., the redirector 16 of U.S. Patent
13 No. 6,375,631, the client processor of Holmberg, or the client driver interface 204
14 of Rizvi) to route the request to the second application (backup) server. Thus, the
15 greater weight of evidence points to the first application server not forwarding the
16 request. This evidence, however, does not appear to be given any weight by the
17 Honorable Board. Instead, the Honorable Board appears to have thrown out this
18 substantial evidence as to routing techniques that would lead away from the
19 claimed invention and, instead, relied upon an alleged teaching within Helmer that
20 was never explicitly set forth by Helmer.

Claims 7 and 11

Despite stating that claims 7 and 11 stand or fall separately from independent claim 1 on page 4 of the Appeal Brief and setting forth arguments as to these claims on pages 8 and 9 of the Appeal Brief and pages 8 and 9 of the Reply Brief, the Decision does not separately address these separately argued claims. As noted in Appellants' prior arguments, the Examiner's analysis lumps claims 7 and 11 together with claim 1. However, claims 7 and 11 recite different limitations than claim 1.

For example, claim 7 is directed to a device, whereas claim 1 is directed to a method. Therefore, the limitations cited in claim 7 are different than claim 1. Moreover, as discussed on pages 8 and 9 of the Reply Brief, claim 11 recites that the first application server forwards the response, which was received from the second application server, to the application client and this limitation is not contained in claim 1. On page 9 of the Reply Brief, Appellants further addressed with the applied prior art fails to teach these limitations. However, the Decision is completely silent as to these arguments. Thus, Appellants respectfully submit that the Honorable Board has overlooked these specific arguments.

1 For the reasons set forth in the Appeal Brief of November 22, 2006, and in
2 the Reply Brief of August 14, 2007, and for those set forth herein, Appellants
3 respectfully solicit the Honorable Board to reverse the Examiner's rejection under
4 35 U.S.C. § 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: November 24, 2008

Respectfully submitted,

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CUSTOMER NUMBER 46320